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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,509	03/28/2005	Christelle Marie Guittet	05-232	6176
20306 7590 05/29/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER SIMS, JASON M				
ART UNIT		PAPER NUMBER		
1631				
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05/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,509

**Applicant(s)**

GUITTET ET AL.

**Examiner**

JASON M. SIMS

**Art Unit**

1631

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 6, 12 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 1-5, 7-11 and 13-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/25/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's election with traverse of species A, claims 1, 7, 13, and their accompanying dependent claims in the reply filed on 1/27/2008 is acknowledged. The traversal is on the ground(s) that the instant application is a National Stage of a PCT and therefore the restriction should be based upon a unity of invention claim analysis. This is not found persuasive because the features of the different claims all have different possible combinations of implementations without necessitating common method steps and therefore lack a unity of invention.

Claims 6, 12, and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/27/2008.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-5, 7-11, and 13-17 are the current claims hereby under examination.

### ***Drawings***

The drawings received on 3/28/2005 have been accepted and entered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 7/25/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 10 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 13 and all claims dependent therefrom, at step d), sub-step iii), comprise the vague and indefinite wording “to provide parameters RATIO.” It appears that the method sub-step iii) results in only one value for only one parameter called RATIO. However, the claim wording gives the appearance that the method sub-step results in several values for several different parameters, wherein the only parameter listed is RATIO. Clearer claim wording is required.

Claims 4, 10, and 16 each comprise the vague and indefinite claim wording “multiplying pixels in the second image (60) by or ANDing them.” It appears that the wording “by or ANDing them” may refer to the addition of pixel values, but it is unclear as to what exactly the wording refers and the specification does not give further guidance as to its meaning. Furthermore, it is unclear as to how to multiply pixel values by ANDing them. Clarification via clearer claim wording is required.

Claims 2, 8, and 14 each comprise the vague and indefinite wording “and each after the first being applied.” It appears that the wording refers to, for example, applying the step of morphological dilation to the outcome of applying inversion to the fourth

image and then applying the step of median filtering to the outcome of applying morphological dilation. However, the claim wording remains unclear as to what exactly it refers. Clarification via clearer claim wording is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 7-11, and 13-17 are drawn to a process and/or apparatus and/or computer program. A statutory process or an apparatus or a computer program that embodies a statutory process must include a final resulting step of a physical transformation, or produce a useful, concrete, and tangible result (State Street Bank & Trust Co. v. Signature Financial Group Inc. CAFC 47 USPQ2d 1596 (1998), AT&T Corp. v. Excel Communications Inc. (CAFC 50 USPQ2d 1447 (1999)). Furthermore, an apparatus without any physical limitations, which recites only "instructions" type of limitations encompasses a program, per se. For instance, claims 7-11 which are drawn to an apparatus without any physical limitations have been broadly and reasonably interpreted as limitations encompassed by a program, per se. What's more, claims 13-17 are drawn to a computer program, per se - i.e. NOT executably disposed on a computer readable medium. A program, per se, is not statutory subject matter. See MPEP 2106.IV.B.

Further, the method to be performed in instant claims do not result in a physical transformation, thus the Examiner must determine if the instant claims include a useful, concrete, and tangible result.

As noted in *State Street Bank & Trust Co. v. Signature Financial Group Inc.* CAFC 47 USPQ2d 1596 (1998) below, the statutory category of the claimed subject matter is not relevant to a determination of whether the claimed subject matter produces a useful, concrete, and tangible result:

The question of whether a claim encompasses statutory subject matter should not focus on *which* of the four categories of subject matter a claim is directed to 9— process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

In determining if the claimed subject matter produces a useful, concrete, and tangible result, the Examiner must determine each standard individually. For a claim to be "useful," the claim must produce a result that is specific, and substantial. For a claim to be "concrete," the process must have a result that is reproducible. For a claim to be "tangible," the process must produce a real world result. Furthermore, the claim must be limited only to statutory embodiments.

Claims 1-5, 7-11, and 13-17 do not produce a tangible result. A tangible result requires that the claims must set forth a practical application to produce a real-world result. In the instant claims such as claims 1,7, and 11, the final method step comprises a determined value for an image's tubules. It is unclear as to what is done with the resulting data of the final method step. For instance, the resulting data may be seed data for another data manipulation program, wherein in the result is clearly not tangible. This rejection could be overcome by amendment of the claims to recite that a result of the method is outputted to a display or to a user, or by including a final resulting step of a physical transformation, if such wording is supported by the instant specification.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is (571)-272-7540.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marjorie Moran can be reached via telephone (571)-272-0720.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61

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(November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)).

The Central PTO Fax Center number is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

// Jason Sims //

/Marjorie Moran/  
Supervisory Patent Examiner, Art Unit 1631